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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/601,693	08/07/2000	LUTZ GOTTSCHALD	P/1568-38	8636

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EXAMINER

VON BUHR, MARIA N

ART UNIT	PAPER NUMBER
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2125

DATE MAILED: 10/03/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/601,693

Applicant(s)

GOTTSCHALD, LUTZ

Examiner

Maria N. Von Buhr

Art Unit

2125

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 August 2000 and 03 October 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 07 August 2000 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 0 and 4.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

1. Claims 1-30 are pending in this application.
2. Examiner acknowledges receipt of Applicant's information disclosure statements, received August 7, 2000 and October 3, 2000, with accompanying reference copies, which have been taken into consideration for this Office action.
3. Receipt is acknowledged of papers submitted under 35 U.S.C. §119(a)-(d), which papers have been placed of record in the file.
4. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.
5. The following guidelines illustrate the preferred layout and content for patent applications. These guidelines are suggested for Applicant's use.

Arrangement of the Specification

The following order or arrangement is preferred in framing the specification and, except for the reference to the drawings, each of the lettered items should appear in upper case, without underling or bold type, as section headings. If no text follows the section heading, the phrase "Not Applicable" should follow the section heading:

- (a) Title of the Invention.
- (b) Cross-Reference to Related Applications.
- (c) Statement Regarding Federally Sponsored Research or Development.
- (d) Reference to a "Sequence Listing," a table, or a computer program listing appendix submitted on compact disc (see 37 CFR §1.52(e)(5)).
- (e) Background of the Invention.
 1. Field of the Invention.
 2. Description of the Related Art including information disclosed under 37 CFR §§1.97 and 1.98.
- (f) Brief Summary of the Invention.
- (g) Brief Description of the Several Views of the Drawing(s).
- (h) Detailed Description of the Invention.
- (I) Claim or Claims (commencing on a separate sheet).
- (j) Abstract of the Disclosure (commencing on a separate sheet).
- (k) Drawings.
- (l) Sequence Listing, if on paper (see 37 CFR §§1.821-1.825).

6. The disclosure is objected to because the specification is not arranged properly, as per the guidelines. The above-noted headings need to be inserted into the specification. Additionally, the abbreviations “CNC” (page 1), “CD” and “PD” (page 4), “CCD” (page 10) and “RX” (page 20) should be specifically defined, at the first instance of their use in the specification. Appropriate correction is required.

7. The drawings are objected to under 37 CFR §1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the method of instant claims 1-17 must be shown or the feature(s) canceled from the claim(s). Also, the “vertex refractionometer” of claim 23 must be shown or the feature(s) canceled from the claim(s). Additionally, the generic boxes labeled ‘18’-‘23’ and ‘26’-‘29’ should include labels, to improve understanding of the figure. No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

8. The following is a quotation of the second paragraph of 35 U.S.C. §112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which Applicant regards as his invention.

9. Claims 1-30 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention.

Regarding claim 1, it is unclear how inputting of data can be performed “by means of a selected spectacle frame,” while there is also no clear antecedent basis for any frames having been selected. The abbreviations “PD” and “CNC” should be specifically defined, at the first instance of their use in the claims. Also, the phrases “that is to say,” “if appropriate” and “such as” render the claim indefinite, because it is unclear whether the limitations following the phrases are part of the claimed invention. See MPEP §2173.05(d). Additionally, “if appropriate” is a relative phrase which renders the claim indefinite, since the phrase is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. There is no clear and proper antecedent basis for “the required rough-cast lens diameter” nor for “the desired diameter,” while there is no clearly presented nexus between the calculation of such a required value and any of the remainder of the steps of the claim. There is further no clear nexus between

the “CNC-controlled machining of the rough-cast lens” and the remainder of the steps of the claim, which presents ambiguity with regard to the relationship, if any, between all the data gathering and calculating steps and the actual control of the machining operation.

In claim 2, there is no clear and proper antecedent basis for any deviations having been “detected.”

In claims 2 and 3, there is no clear and proper antecedent basis for “the machining data.”

In claim 4, it is not clear whether “is or is not possible” is a relative phrase which renders the claim indefinite, since the phrase is not clearly defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

In claim 5, “positionally accurate” is a relative phrase which renders the claim indefinite, since the phrase is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

Claim 6 is grammatically awkward, so it is unclear what is being displayed.

In claim 7, there is no clear and proper antecedent basis for “the data required for the spectacle lens machining.”

In claim 8, the phrase “such as” renders the claim indefinite, because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP §2173.05(d).

In claims 9-12, the clause “and the data are led to the computer” is not understood.

Further in claims 12 and 13, “suitable” is a relative term which renders the claim indefinite, since the term is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

In claim 14, the clause “and/or is taken over from a computer” is not understood.

In claims 15-17, ambiguity has been introduced with regard to the actual CNC-controlling of the machining, since it is unclear how the “long-distance transmission” of the data to a third party relates to the previously claimed CNC-controlled machining. Also, in claims 16 and 17, there is no clear context for any

“final” machining. Further in claim 17, there is no clear and proper antecedent basis for any “delivered” rough-cast lens.

Claim 18 is an improper hybrid claim, since it is unclear what the nexus is between the individual steps of the method of claim 7, and each of the instantly claimed elements of the apparatus. Also, the phrase “such as” renders the claim indefinite, because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP §2173.05(d).

In claim 28, the abbreviation “CCD” should be specifically defined, at the first instance of its use in the claims.

Claim 29 is grammatically awkward, so it is unclear what is being displayed. Also, there is no clear and proper antecedent basis for “the correct position” nor for “the spectacle lens edging tool.”

In claim 30, the phrase “if appropriate” renders the claim indefinite, because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP §2173.05(d). Also, there is no clear context for “an aftercut.”

The remainder of the claims stand rejected as necessarily incorporating the above-noted ambiguities of their parent claims.

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. §102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

11. As best understood by Examiner, in view of the numerous above-noted ambiguities within the claims, claims 1-8, 13, 14, 18, 19 and 24-30 are rejected under 35 U.S.C. §102(b) as being clearly anticipated by Wood (U.S. Patent No. 5210695; newly cited). This reference discloses a “method and related system and article [that] provides a lens blank and block assembly capable of being mounted in any of a surface generating machine, a finishing apparatus and an edging machine without requiring re-blocking of the lens in order to compensate for axis shifts. The method and associated system utilizes a controller which takes data inputted to it in the form of prescription information and a frame opening shape and

converts it into two sets of machine operating data together used by a computer to allow the surface to be generated on the blank so as to be readily shaped edgewise according to a selected frame pattern by simply the mounting blank and block assembly in the edging machine thereafter. The blank is separated from the block assembly and readily inserted into a selected glass frame" (the abstract), wherein the disclosed "lens blank" of Wood is equivalent to Applicant's instantly claimed "rough-cut lens." See also, at least Figs. 4 and 8, with accompanying text; col. 1, lines 29-39 and 51-53; col. 3, lines 13-15 and 29-44; col. 3, line 63 - col. 4, line 2; col. 4, lines 16-18; col. 4, line 36 - col. 5, line 11; col. 7, line 45 - col. 8, line 18; col. 9, line 48 - col. 10, line 48, where details are given regarding types of input data and calculations performed to accomplish the automatic machining in response to prescription and selected frame information.

12. The following is a quotation of 35 U.S.C. §103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. Claims 9-12 and 20-22 are rejected under 35 U.S.C. §103(a) as being unpatentable over Wood (U.S. Patent No. 5210695) as applied to claim 1 above, and further in view of Kimura (U.S. Patent No. 5926247; newly cited).

As per the claims, Wood does not specify scanning a frame to determine shape data, nor using markings on the frame to identify the frames. In this regard, Kimura teaches a "method of manufacturing spectacles by obtaining accurate frame shape information without performing a frame shape measurement in the spectacle store. In this method, frame shape information is first obtained after a spectacle frame is manufactured in a factory. Moreover, frame-related information, which includes the obtained frame shape information, or readout information, according to which this frame-related information is read out, is preliminarily added to the spectacle frame" (the abstract). It would have been obvious, to one having ordinary skill in the art, at the time the instant invention was made, to modify the system of Wood to include such frame shape determination, since Kimura teaches a resultant increase in the accuracy of obtaining frame shape information.

14. Claims 15-17 are rejected under 35 U.S.C. §103(a) as being unpatentable over Wood (U.S. Patent No. 5210695) as applied to claim 1 above, and further in view of Ace (U.S. Patent No. 4656590; newly cited).

As per the claims, Wood does not specify distributing lens machining data to multiple parties. In this regard, Ace discloses a “system for computerizing eyeglass geometrical frame pattern records at a central location for access by eyeglass retailers or wholesalers. The pattern records are stored in a central computer in the form of instructions for a remote pattern cutting machine” (the abstract). It would have been obvious, to one having ordinary skill in the art, at the time the instant invention was made, to modify the system of Wood to include such distribution of lens machining data, since Ace teaches a resultant simplification of lens preparation for fitting lenses in frames.

15. Claim 23 is rejected under 35 U.S.C. §103(a) as being unpatentable over Wood (U.S. Patent No. 5210695) as applied to claim 1 above, and further in view of Fukuma et al. (U.S. Patent No. 5971537; newly cited).

As per the claim, Wood does not specify using a lens meter (i.e.; instantly claimed “vertex refractionometer”) to measure existing lens characteristics. In this regard, Fukuma et al. teach the use of such a lens meter (the abstract). It would have been obvious, to one having ordinary skill in the art, at the time the instant invention was made, to utilize such a lens meter in the system of Wood, because Fukuma et al. teach a resultant increase in accuracy of acquiring lens characteristic information.

16. The prior art made of record and not relied upon is considered pertinent to Applicant's disclosure.

17. **Any response to this Office action should be mailed to:**

Commissioner of Patents and Trademarks
Washington, D.C. 20231

Or faxed to the Office at:

(703) 746-7239 - for formal communications intended for entry, mark "FORMAL";
(703) 746-7240 - for informal/draft communications; label "PROPOSED" or "DRAFT".

Hand-delivered papers should be brought to Crystal Park II, 2121 Crystal Dr., Arlington, VA, 4th Floor (Receptionist).

Serial No. 09/601,693
Art Unit 2125

- page 8 -

18. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Maria N. Von Buhr whose telephone number is (703) 305-3837. The Examiner can normally be reached on Monday-Friday between 9:00 A.M. and 5:00 P.M.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's Supervisor, Leo Picard can be reached at (703) 308-0538.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-3900.



MARIA N. VON BUHR
PRIMARY PATENT EXAMINER
ART UNIT 2125

MNVB
9/27/03